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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,745	12/30/2003	Jonathan Leblang	MIPS.100A	2677
29995 7590 03/23/2009 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER JOSEPH, TONYA S				
ART UNIT 3628		PAPER NUMBER		
NOTIFICATION DATE 03/23/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/748,745

Applicant(s)

LEBLANG, JONATHAN

Examiner

TONYA JOSEPH

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 50-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 50-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status Of Claims

Claims 1-13 and 50-62 have been previously examined. Claims 14-49 and 63-78 have been cancelled. No claims have been amended. Thus claims 1-13 and 50-62 have been presented for examination.

Response to Arguments

1. Applicant's arguments filed 12/17/2008 have been fully considered but they are not persuasive.
2. Applicant argues with respect to claims 1-3, 6-8, 13, 21, 50, 52, 55-57 and 62, *"In rejecting Claims 1 and 50, the Office Action alleges that Knorr, at paragraph 65, discloses "a second module that, based at least in part on information retrieved from the database, identifies at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order". However, a careful reading of the citation relied upon by the Office Action fails to disclose the foregoing elements or even a mention of identifying at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order. The Examiner disagrees. The cited portion of Knorr plainly teaches that a vendor can use the time between the electronic hold and the ultimate order execution-(shipment of the items) to plan inventory and interact with the purchaser for up-sellings or cross-selling. Furthermore, Knorr makes no mention or suggestion of halting or delaying shipping as a result of the addition of these items. One can reason, the fact that Knorr tries to cross-sell a customer before the order is shipped further*

supports the Examiner's conclusion that the addition of items is "without delaying the shipment date of the pending order".

3. *Applicant further asserts, "The Office Action further alleges that paragraph 65 of Knorr discloses a third module that causes a notification to be presented to the user, wherein the notification indicates that the user can add at least the first article to the pending order without delaying the pending order shipment. In making this assertion, the Office Action states that the Office Action is interpreting interacting with the customer as notifications. Again, a careful reading of the citation relied upon by the Office Action fails to disclose the foregoing elements".* The Examiner disagrees. As shown in the Examiner's arguments above, Knorr teaches that a vendor can use the time between the electronic hold and the ultimate order execution-(shipment of the items) to plan inventory and interact with the purchaser for up-sellings or cross-selling (see para. 65). This interaction alone, is an indication that the user can add the first article to the pending order, as required by the claim. Accordingly, the cited portion of Knorr is more than sufficient to meet Applicant's claim language and the rejection is maintained.

4. *Applicant further asserts with respect to claims 9 and 58, "...Cross selling does not inherently include identifying an article based in part on at least one article type in the pending order. Cross-selling is a broad term, with different potential meanings. For example, Webster's New Millennium TM Dictionary defines "cross-sell" as follows: "to suggest that customers buy additional, complementary, or related accessories or products during or just after their primary purchase." Webster's New Millennium TM*

Dictionary of English, Preview Edition (v 0.9.7). Lexico Publishing Group, LLC. 18 Nov. 2008. Thus, because cross selling may merely refer to suggesting that customers buy additional products, Knorr does not inherently or expressly disclose wherein the first article is identified based in part on at least one article type in the pending order..." The Examiner respectfully disagrees. Applicant is mischaracterizing the dictionary definition. Applicant concedes that cross-sell means *"to suggest that customers buy additional, complementary, or related accessories or products during or just after their primary purchase."* The terms additional, related and complementary are plainly tied to a particular thing. Applicant should ask himself if something is in addition to, complimentary to or related to something, aren't there essentially at least two items? The answer is yes. The at least two items are the original item and the (the item being compared or added). Applicant's claim only requires an article is identified based in part on an another article type. An article type can be as broad as anything in a user's shopping cart and as narrow as the same manufacturer. Applicant has only broadly claimed an article type. The addition of items to a pending order via cross-selling as taught in Knorr is sufficient to meet the limitations of the claim language.

5. Applicant further argues with respect to claims 10 and 59, *While Knorr refers to a pending order database and to suggestive selling, the citation relied upon by the Office Action does not expressly or inherently disclose that the suggestive selling of Knorr involves identifying an article that can be added to the pending order based in part on user history order information retrieved from a database, much less the invention as*

claimed. The Examiner disagrees. Knorr's suggesting cross-items based on a pending order is the same as identifying an article based in part on user history (see para. 65).

6. Applicant further asserts with respect to claims 12 and 61, *"While paragraph 65 of Knorr mentions suggestive selling, including cross selling, and paragraph 42 mentions a recipient profile (as opposed to a purchaser profile), the citations relied upon by the Office Action do not expressly or inherently disclose that the suggestive selling of Knorr involves identifying an article that can be added to the pending order based in part on preference information of a user placing an order, wherein the preference information is retrieved from a database"* Knorr plainly teaches this limitation (see para. 42-43).

7. In response to applicant's argument with respect to claims 4 and 53 that, *"...the notification referred to in the claim is not providing the status of an ordered item. Instead, notification indicates that a user can add at least the first article to a pending order without delaying the pending order shipment. Thus, for at least this reason, the Office Action has failed to make a prima facie case of obviousness"*, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

8. In response to applicant's argument with respect to claims 11 and 60 that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to

produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art of order fulfillment would have had the general knowledge to perform the old and well known combination as described.

9. Applicant further argues with respect to claims 5 and 54 that the Examiner's Official Notice of a notification including a link and providing a notification to a user that a link is expired is novel and unobvious. The Examiner disagrees and has cited a reference along with this Office Action to support the reasoning behind using Official Notice and a notification including a link and providing a notification to a user that a link is expired would have been obvious to one of ordinary skill in the art. For example:

- Shmukler et al [2005/0021664 A1] discloses a user receiving a link in a notification and also being notified that a link is expired (see para. 82 and 84-86).

Examiner also submits that the citation of the reference above, added as evidence to substantiate the prior Official Notice statement, does not result in a new issue, and therefore this action will be made Final.

10. Applicant has not challenged Examiner's use of Official Notice with respect to the subject matter of claims 8, 11, 57 and 60. Thus, the Examiner's use of Official Notice of the pertinent facts is considered admitted prior art.

Claim Objections

11. Claim 50 is objected to because of the following informalities:
12. Applicant's preamble recites, "an apparatus stored on a computer readable medium". **Appropriate correction is required.**

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1, 3, 6, 9-10, 12-13, 50, 52, 55, 58-59 and 61-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1.

15. As per Claims 1 and 50, Knorr teaches a database that stores article identification information and article location information for a plurality of articles (see para. 17 and 22); a first module that determines at least a shipment date when a pending user order is to be shipped, wherein the pending order was placed via a computer network during a first network session (see para. 50); a second module that, based at least in part on information retrieved from the database, identifies at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order (see para. 65); and a third module that causes a notification to be presented to the user, wherein the notification indicates that the user can add at least the first article to the pending order without delaying the

pending order shipment (see para. 65, Examiner is interpreting interacting with the customer as notifications).

16. As per Claims 3 and 52, Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the third module causes the notification to be presented to the user at least partly in response to determining that the user is accessing the computer network (see para. 42).

17. As per Claims 6 and 55 Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the notification includes an order incentive offer (see para. 42).

18. As per Claims 9 and 58, Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the first article is identified based in part on at least one article type in the pending order (see para. 65, Examiner is interpreting cross-selling as being based on an article type of a pending order).

19. As per Claims 10 and 59, Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the first article is identified based in part on user history order information retrieved from the database (see para. 65).

20. As per Claim 12 and 61, Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the first article is identified based in part on user preference information retrieved from the database (see para. 42 and 65).

21. As per Claim 13 and 62, Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the notification is provided to the user at least-one after the pending order was placed (see para. 42 and 65).

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 2 and 51 are rejected under 35 U.S.C. 103(a) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1 in view of Marston et al. U.S. Pre-Grant Publication No. 2004/0260710 A1.

24. As per Claims 2 and 51, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach the limitation taught by Martson wherein the notification is an icon displayed via a toolbar on a user terminal (see para. 32). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Marston to alert a user of a change in a system.

25. Claims 4 and 53 are rejected under 35 U.S.C. 103(a) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1 in view of Shinohara et al. U.S. Pre-Grant Publication No. 2003/0097311 A1.

26. As per Claim 4 and 53, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach the limitation taught by Shinohara wherein the notification is provided via an email transmitted to a user email address (see para. 187). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention

to modify the system of Knorr to include the teachings of Shinohara to receive the status of an ordered item.

27. Claims 5 and 54, are rejected under 35 U.S.C. 103(a) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1 in view of Shmukler et al 2005/0021664 A1.

28. As per Claims 5 and 54, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach the limitation taught by Shmukler wherein the notification includes a link, wherein if the user activates the link after the first amount of time, the user is provided a message indicating that the first amount time to add articles to the pending order has expired (see para. 82 and 84-86). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Shmukler to provide adequate order and offer information to a user.

29. Claims 8, 11, 57 and 60 are rejected under 35 U.S.C. 103(a) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1 in view of Official Notice.

30. As per Claims 8 and 57, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach wherein the location information is used by the second module to determine how long it would take to transport the first article from a storage area to a packing area. Official Notice is taken that using location information to determine transport time to an area is old and well known. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the

system of Knorr to include the teachings of Official Notice to calculate an estimated shipment date.

31. As per Claims 11 and 60, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach, wherein the first article is identified based in part on the quantity of the first article in inventory in an order fulfillment center from which at least one article in the pending order is to be shipped. Official Notice is taken that identifying an article based on a quantity available in a shipping center is old and well known. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Official Notice to up-sell overstocked items.

32. Claims 7 and 56 are rejected under 35 U.S.C. 103(a) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1 in view of Silverbrook et al. U.S. Pre-Grant Publication No. 2003/0130903.

33. As per Claims 7 and 56, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach the limitation taught by Silverbrook a fourth module, that, during a second network session, provides that user with an interface via which the user can add the at least first article to the pending order (see para. 558). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Silverbrook to allow a user the flexibility to alter an order.

Conclusion

34. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **TONYA JOSEPH** whose telephone number is (571)270-1361. The examiner can normally be reached on Mon-Fri 7:30am-5:00pm First Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571 272 0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tonya Joseph
Examiner
Art Unit 3628

/John W Hayes/
Supervisory Patent Examiner, Art Unit 3628